

## **REMARKS**

Claims 1-20 are pending in the application. Claims 1, 10 and 15 are the independent claims. Claims 1-9 stand rejected. Claims 10-20 are objected to.

### ***Interview summary***

Applicants' undersigned representative thanks Examiner Brier for the courtesy extended in the telephonic interview of May 29, 2009. The interview consisted of a discussion of the outstanding issues in the pending application as amplified herein below. Examiner Brier agreed that the amendments to claim 1 overcome the 112 and 101 rejections. Examiner Brier agreed to reconsider the arguments regarding the objection to the specification.

### ***Specification***

The specification was objected to as failing to provide proper antecedent basis for the claimed subject matter.

The Office maintains that the limitation found in claims 6, 12, and 16 "a surface normal vector" is not found in the specification.

Applicants respectfully disagree. As previously indicated, the phrase is clearly described at least on page 5 of the specification. The meaning of the phrase is clearly "ascertainable by reference to the description." 37 C.F.R. § 1.75(d)(1). Moreover, the same language appeared in original claim 6. Original claim 6 formed part of the specification. See MPEP 608.01(o).

In the most recent rejection, the Office addressed the Applicants' arguments and indicated that:

Page 5 line 2 lists "N = outward surface normal vector at a pixel" which is different narrow than the claimed "a surface normal vector". The argument concerning the objection to the specification is not persuasive because the list of parameters on pages 4 and 5 includes "outward surface normal vector at the pixel" while claim 6 with reference to claim 3 lists a surface normal vector. A parameter for a pixel discussed in the background of the invention at pages 4 and 5 is different than a parameter for a vertex discussed in the detailed specification at

page 12, thus, the background description cannot be used to provide proper antecedent basis for the claimed subject matter due to the differences in words used in the claim and the background of the invention.

Action p. 2. However, by citing the section of the specification, the applicant demonstrated that consistent terminology was used in the specification and the claims, whether or not the surface normal vector applied to a pixel or a primitive. Moreover, and more importantly, the Office's analysis incorrectly states the law and misapplied the MPEP.

Notably, the Office's Response to Arguments did not address a very fundamental point raised by the Applicants: **original claims form part of the specification**. Thus, because claim 6, for example, is an original claim, surface normal vector was included in the specification as originally filed and the claim has proper support whether or not that support is also listed earlier in the specification. See MPEP § 608.01(o).

The Office also cites to MPEP § 608.01(o), but that very section of the MPEP makes clear that it is referencing new claims and claim amendments in clear contrast to an original claim, which *is* part of the specification. This point is amply illustrated by the highlighted portions of that section of the MPEP as reproduced below:

Usually the terminology of the original claims follows the nomenclature of the specification, but *sometimes in amending the claims or in adding new claims, new terms are introduced that do not appear in the specification*. The use of a confusing variety of terms for the same thing should not be permitted.

*New claims and amendments to the claims already in the application should be scrutinized* not only for new matter but also for new terminology. While an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification *whenever this nomenclature is departed from by amendment of the claims* so as to have clear support or antecedent basis in the specification for the *new terms appearing in the claims*. This is necessary in order to insure certainty in construing the claims in the light of the specification, *Ex parte Kotler*, 1901 C.D. 62, 95 O.G. 2684 (Comm'r Pat. 1901). See 37 CFR 1.75, MPEP § 608.01(i) and § 1302.01. Note that *examiners should ensure that the terms and phrases used in claims presented late in prosecution of the application* (including claims amended via an examiner's amendment) find clear support or antecedent basis in the description so that the meaning of the

terms in the claims may be ascertainable by reference to the description, see 37 CFR 1.75(d)(1). ***If the examiner determines that the claims presented late in prosecution*** do not comply with 37 CFR 1.75(d)(1), applicant will be required to make appropriate amendment to the description to provide clear support or antecedent basis for the terms appearing in the claims provided no new matter is introduced.

MPEP § 608.01(o) (Bold italics added). The MPEP could not be more clear. Original claim language is part of the specification. MPEP § 608.01 describes antecedent basis problems that arise from presenting *new* claims or claim *amendments* to an original claim. That is not the fact in the present application.

Reconsideration is respectfully requested.

#### ***Claim Objections***

Claims 1-20 stand objected to because of informalities. The Office asserts that a comma or semicolon is needed in claim 1 at line 9 after "parameters", claim 10 at line 9 after "primitive", and claim 15 at line 15 after "value."

Applicants have amended the claims to correct the informalities.

Claims 2-9 stand objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicants disagree but have nevertheless amended claim 1 to address the issue.

#### ***Claim Rejections - 35 USC §112***

Claims 1-9 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Office asserts that:

These claims claim "In a computer graphics system and "a method for applying ... the method comprising", thus, these claims are unclear if the invention is a machine or a process.

Action. p. 4-5. Applicants respectfully disagree. Nevertheless, the claim was amended to recite more clearly that the claim recites a method tied to a computer graphics system.

Reconsideration is respectfully requested.

***Claim Rejections - 35 USC § 101***

Claims 1-9 stand rejected under 35 U.S.C. 101 because the claimed invention is purportedly directed to non-statutory subject matter. The Office alleges two bases for the 101 rejection. First, the Office essentially reasserts the rejection above that was made under § 112:

These claims claim in parent claim 1 "In a computer graphics system" and "a method for applying ... the method comprising", thus, these claims are unclear if the invention is a machine or a process.

Action. 5-6. Applicants again disagree and submit that this is not a proper basis for a § 101 rejection. Nevertheless, the amendment made to claim 1 clarifies any ambiguity that the Office may allege.

Second, the Office asserts that the claim is not tied to a machine nor transforms underlying subject matter to a different state or thing. Applicants disagree and submit that the language "In a computer graphics system" clearly tied the claimed method to a machine. However, Applicants further clarified that the method is or use in a machine. The amended language similarly passes muster under § 101. Additionally, the claim teaches the transformation of texture values, for instance, into a pixel value and therefore recite a transformation of subject matter.

Reconsideration and withdrawal of the rejection is respectfully requested.

***Allowable Subject Matter***

Applicants acknowledge and thank the examiner for recognizing the allowability of claims 10-20. Applicants submit that all objections to those claims are overcome.

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**PATENT**

### **CONCLUSION**

In the view of the foregoing amendments and remarks, Applicants respectfully submit that the present application is in condition for allowance. Reconsideration of the application and an early Notice of Allowance are respectfully requested. In the event that the Examiner cannot allow the application for any reason, the Examiner is encouraged to contact Applicants' representative.

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